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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,916	07/15/2003	Mark C. Mattson	89222.0007	7158
26021	7590	11/03/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			SAN MARTIN, EDGARDO	
			ART UNIT	PAPER NUMBER
			2837	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,916

Applicant(s)

MATTSON ET AL.

Examiner

Edgardo San Martin

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1 – 8, 11, 15 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Shimizu et al. (US 2002/0144852).

With respect to claims 1, 15, Shimizu et al. teach a vibration isolation mounting element (Figs.4 - 6, Item 70), the vibration isolation mounting element comprising a first mounting member (Figs.5 and 6, Item 74) configured for mounting to a first structure (Fig.4), a second mounting member (Figs.5 and 6, Item 76) configured for mounting to a second structure; and a vibration isolation material (Figs.5 and 6, Item 84) disposed between the first mounting member and the second member to hold the first and second mounting members together while isolating the first structure from vibration produced by the second structure (Figs. 4 – 6; ¶ [0038] – [0044]).

The Examiner considers that the limitations describing the limitations indicating “for a motorized garage door opener system” is intended use, and has given little patentable weight to this limitation, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

With respect to claims 2 – 8, 11, 15 and 18, Shimizu et al. teach wherein the first mounting member includes a substantially planar flat plate (Figs.5 and 6, item 74); wherein the substantially planar flat plate includes an interface region in contact with the vibration isolation material (Figs.5 and 6, Item 84) and a flange region (Figs.5 and 6, Item 78) that extends away from the vibration isolation material; wherein the flange region includes an element defining at least one aperture (Figs.5 and 6, Item 78) configured to receive a fastener for mounting the vibration isolation mounting element to the first structure; wherein the flange region includes an element defining at least two apertures (Fig.5, Item 78), each the aperture configured to receive a fastener for mounting the vibration isolation mounting element to the first structure; wherein at least two of the apertures are aligned in a common horizontal plane when the vibration isolation mounting element is mounted to the first structure (Figs.5 and 6); wherein the second mounting member includes a substantially planar flat plate (Figs.5 and 6, Item 76); wherein the second mounting member includes at least one fastening element (Figs.5 and 6, Item 80) attached to the substantially planar flat plate, wherein the fastening element is configured for mounting to a member mounted to the second structure (Fig.4); and wherein the fastening element is a threaded bolt shaft configured to receive a nut to fix the vibration isolation mounting element to the member mounted to the second structure (Figs.4 – 6; ¶ [0038] – [0044]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9, 10, 12 – 14, 16, 17 and 19 – 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (US 2002/0144852) in view of Lhotak et al. (US 5,761,850).

With respect to claims 9, 10, 12, 13, 16, 17, 19 and 20, Shimizu et al. teach the limitations discussed in a previous rejection, but fail to disclose wherein the second mounting member includes at least two fastening elements attached to the substantially planar flat plate, wherein each of the fastening elements is configured for mounting to a member mounted to the second structure, and being aligned in a common horizontal plane when the vibration isolation mounting element is mounted to the first structure.

The Examiner considers that it would have been an obvious matter of design choice to employ a plurality of fastening elements because it would provide with a better load distribution characteristic and a more secure attachment between the structures; furthermore, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With respect to claims 14 and 21, Shimizu et al. teach the limitations discussed in a previous rejection, but fail to disclose wherein the first and second mounting members

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are formed of metal. Nevertheless, the Examiner considers that it would have been an obvious matter of design choice to employ metal plates as the first and second mounting members because it is a strong material that would sustained high loads and temperature; in addition, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claims 22 and 42, Shimizu et al. teach the limitations discussed in a previous rejection, but fail to disclose wherein the vibration isolation mounting element is mounted to a motor mounting structure mounted to a motor of a garage door opener system.

On the other hand, Lhotak et al. teach a motor mounting structure (Fig.4, Item 14) mounted to a motor (Fig.4, Item 20) of a garage door opener system (Fig.4, Item 10).

It would have been obvious to a person with ordinary skill in the art at the time of the invention was made to employ the Shimizu et al. vibration isolation mounting element to fix the Lhotak et al. motor mounting structure to the ceiling because the vibration isolation mounting element would isolate vibrations that could produce undesired noise, and vibrations that could damage the ceiling.

With respect to claims 23 – 29 and 43 – 47, Shimizu et al. teach the limitations described in the claims, as discussed above with respect to claims 2 – 8, respectively.

With respect to claims 30 – 35 and 48, the claims stand rejected under the same basis as of claims 9 – 14, respectively, as discussed above.

With respect to claims 36 – 40 and 49 – 53, Lhotak et al. teach wherein the motor mounting structure (Fig.4, Item 14) includes a substantially planar motor mounting plate (Fig.4), wherein the motor (Fig.4, Item 20) is configured for mounting to an underside of the motor mounting plate (Fig.4); and wherein the motor mounting structure includes at least two mounting flanges (Fig.4), and wherein the second mounting member of each of two vibration mounting elements is configured for mounting to one of the mounting flanges, and wherein the two mounting flanges are disposed on opposite sides of a motor mounting plate (Fig.4, Item 14), and wherein the motor (Fig.4, Item 20) is configured for mounting to an underside of the motor mounting plate (Fig.4).

With respect to claims 41 and 54, the obvious combination of Shimizu et al. in view of Lhotak et al. teach the limitations described in the claim, as discussed above.

With respect to claim 55, the obvious combination of Shimizu et al. in view of Lhotak et al. teach the limitations described in the claim, as discussed above with respect to claims 22, 25 and 29.

Conclusion

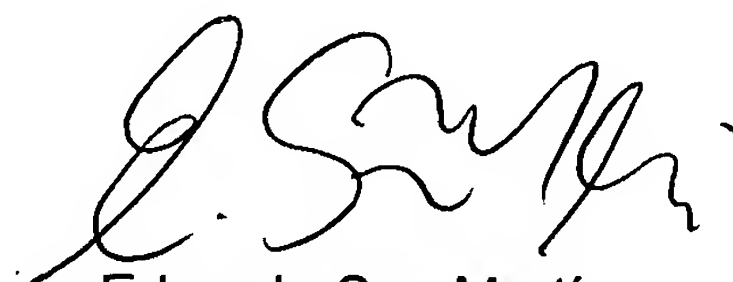
3. The attached hereto PTO Form 892 lists prior art made of record that the Examiner considered it pertinent to applicant's disclosure.

Contact Information

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edgardo San Martin whose telephone number is (571) 272-2074. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (571) 272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edgardo San Martin
Primary Examiner
Art Unit 2837
Class 181
October 29, 2005